

### REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3-34, and 35-39 are pending in this application. Claims 2 and 34 are canceled without prejudice or disclaimer, Claims 1, 21, and 29 are amended, and new Claims 36-39 are added by the present amendment. As Amended Claims 1, 21, and 29 and new Claims 36-39 are supported by the original claims, no new matter is added.

In the outstanding Official Action, Claims 1, 2, 21, 22, 29-32, and 35 were rejected under 35 U.S.C. §102(e) as anticipated by Lombardino (U.S. Patent No. 6,751,891); Claims 1, 21, 22, 29, 30, 33, and 35 were rejected under 35 U.S.C. §102(e) as unpatentable over Jacinto (U.S. Patent No. 4,592,153); Claims 2-5 were rejected under 35 U.S.C. §103(a) as unpatentable over Jacinto in view of Lombardino; and Claims 15, 16, 23-26, and 34 were rejected under 35 U.S.C. §103(a) as unpatentable over Jacinto in view of Preman et al. (U.S. Patent No. 5,224,280, hereinafter "Preman").

As Claim 1 is amended to include the subject matter of Claim 2, the rejections of Claim 2 will be addressed herein with respect to amended Claim 1. Initially, the rejection of Claim 2 as anticipated by Lombardino is respectfully traversed.

Amended Claim 1 recites, *inter alia*, "said at least one cushioning element is disposed in said aperture such that said at least one cushioning element can be seen and touched from an exterior of said shoe."

The outstanding Office Action cited upper extrusions 24 and lower extrusions 28 of Lombardino as "at least one cushioning element."<sup>1</sup> Further Figure 1 of Lombardino was cited as showing that the extrusions 24 and 28 "can be seen and touched from an exterior of

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<sup>1</sup>See Outstanding Office Action, page 2, lines 18-19.

said shoe.”<sup>2</sup> However, Lombardino describes extrusions 24 and 28 as enclosed in encasement 20, shown in Figure 1 of Lombardino:

The encasement 20 is preferably constructed of a transparent or semi-transparent material utilized in combination with a cutout 6 within the mid-sole 14 thereby allowing individuals to view the inventive device in operation.<sup>3</sup>

Accordingly, it is respectfully submitted that Lombardino does not teach that extrusions 24 and 28 can be touched from the exterior of the shoe. Since Lombardino does not teach “at least one cushioning element” as recited in amended Claim 1, Claim 1 (and Claims 3-20 dependent therefrom) is not anticipated by Lombardino and is patentable thereover.

With regard to the rejection of Claim 2 as unpatentable over Jacinto in view of Lombardino, it is respectfully noted that the outstanding Office Action conceded on page 5, lines 9-12 that Jacinto does not teach “said at least one cushioning element is disposed in said aperture such that said at least one cushioning element can be seen and touched from an exterior of said shoe.”

With regard to the rejection of Claims 15 and 16 as unpatentable over Jacinto in view of Preman, as Preman is not relied upon to provide these features of original Claim 2 identified as deficient within Lombardino, Preman is not substantively addressed here.

Accordingly, it is respectfully submitted that amended Claim 1 is patentable over any combination of Jacinto, Lombardino, and Preman. Accordingly, Claims 3-20 are also believed to distinguish over the cited art.

With respect to the rejection of Claim 21 as anticipated by Lombardino, that rejection is also respectfully traversed.

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<sup>2</sup>See Outstanding Office Action, page 2, lines 24-25.

<sup>3</sup>Lombardino, column 6, lines 54-57.

Amended Claim 21 recites an athletic shoe comprising:

- (a) a sole assembly;
- (b) a plurality of cushioning arrangements provided across a width of said sole assembly, said plurality of cushioning arrangements including:
  - (i) a first cushioning assembly disposed on a medial side of said shoe;
  - (ii) a second cushioning assembly disposed adjacent to said first cushioning assembly on a lateral side of said first cushioning assembly;
  - (iii) a third cushioning assembly on a lateral side of said second cushioning assembly;
  - (iv) a fourth cushioning assembly disposed such that said third cushioning assembly is disposed between said second and fourth cushioning assemblies; and
  - (v) a fifth cushioning assembly disposed on a lateral side of said shoe.

In contrast, Figure 11 of Lombardino, cited in the outstanding Office Action as describing first through fifth cushioning assemblies,<sup>4</sup> illustrates a shoe with three compression springs across the width of the shoe. However, amended Claim 21 requires at least **four** cushioning assemblies across the width of the shoe: the first on a medial side, the second adjacent to and on a lateral side of the first, the third on a lateral side of the second, and the fourth disposed such that said third cushioning assembly is disposed between said second and fourth cushioning assemblies (the location of the fifth with respect to the fourth is not limited by Claim 21.) Consequently, it is respectfully submitted that Lombardino does not teach first through fourth cushioning assemblies as recited in amended Claim 21. Accordingly, Claim 21 (and Claims 22-28 dependent therefrom) are believed to be patentable over Lombardino.

With respect to the rejection of Claim 21 as anticipated by Jacinto, that rejection is respectfully traversed.

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<sup>4</sup>See outstanding Office Action at page 3, lines 1-5.

The outstanding Office Action apparently cites shaft 25 of Jacinto as “a first cushioning element” and shaft 33 of Jacinto as “a second cushioning element.”<sup>5</sup> However, shaft 33 of Jacinto is on a *front* side, not on a lateral side, of shaft 25. Further, shaft 35 of Jacinto, apparently cited as “a third cushioning element,” is on a *front* side, not a lateral side of shaft 33. Accordingly, Jacinto does not teach “a second cushioning element” or “a third cushioning element” as recited in amended Claim 21. Consequently, Claim 21 (and Claims 22-28 dependent therefrom) are believed to be patentable over Jacinto.

With regard to the rejection of Claims 23-26 as unpatentable over Jacinto in view of Preman, as Preman is not relied upon to provide these features identified as deficient within Jacinto, Preman is not substantively addressed here. Accordingly, Claims 23-26 are believed to be patentable over any combination of Jacinto and Preman.

As Claim 29 is amended to include the subject matter of Claim 34, the rejection of Claim 34 will be addressed herein with respect to amended Claim 29. Thus, with respect to the rejection of Claim 29 as unpatentable over Jacinto in view of Preman, that rejection is respectfully traversed.

Amended Claim 29 recites an athletic shoe comprising:

at least one cushioning element; and  
a stiffening spring at least partially surrounding said at least one cushioning element, wherein said stiffening spring has a stiffness greater than said at least one cushioning element, and said stiffening spring has a curved top disposed above said plurality of cushioning elements and a substantially flat bottom disposed below said plurality of cushioning elements.

The outstanding Office Action does not cite either reference as describing “a substantially flat bottom” and cites Preman as describing “that the top wall 13 of a stiffening spring 4 can be curve to help in absorbing the impact of a user’s foot with the ground.” The Office Action then concludes, “Therefore, it would have been obvious to make the top wall

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<sup>5</sup>See outstanding Office Action, page 3, lines 17-19.

of the stiffening spring of Jacinto '153 curved to aid in cushioning the impact of the user's foot with the ground."<sup>6</sup> However, it is respectfully submitted that Jacinto teaches away from the present invention, and the proposed combination would make the apparatus disclosed in Jacinto unsuitable for its intended purpose.

Jacinto describes an arrangement for attaching the Z-shaped plate to a heel construction, as shown in Figure 4.<sup>7</sup> It is respectfully submitted that if the upper plate 13 of the Z-shaped plate were curved according to the proposed combination, attaching the Z-shaped plate to the heel construction as described in the above cited portion of Jacinto would be very difficult, if not impossible. At a minimum, the parts of the construction would need to be machined extensively to accommodate a curved upper surface of the Z-shaped plate. This directly contradicts the stated purpose of Jacinto, which is to provide a heel construction with a relatively simple design which allows for simple manufacture "without the need for development of complex machining and manufacturing techniques."<sup>8</sup> Accordingly, it is respectfully submitted that there is no motivation for the combination proposed by the outstanding Office Action.

Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As there is no evidence of a motivation or a suggestion to provide "a stiffening spring" as recited in amended Claim 29, the Office Action must be relying upon the teachings of the present specification to modify Jacinto in the manner proposed. For example, no portion of either reference is cited as providing a motivation to combine the teachings of the two references to create the claimed stiffening spring. In addition, as discussed above, Jacinto actually teach away from the proposed combination. Accordingly, it is respectfully submitted that the

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<sup>6</sup>See outstanding Office Action, page 6, lines 5-8.

<sup>7</sup>See Jacinto, column 5, line 63 to column 6, line 44.

<sup>8</sup>Jacinto, column 7, lines 60-61.

outstanding Office Action has engaged in improper hindsight reconstruction in view of the present specification.

New Claim 36 includes the subject matter of original Claim 17, which was indicated as including allowable subject matter. New Claims 37-39 correspond to original Claims 18-20, respectively, which were also indicated as including allowable subject matter. Accordingly, new Claims 36-39 are believed to be in condition for allowance.


Accordingly, in view of the present amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
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Steven P. Weihrouch  
Attorney of Record  
Registration No. 32,829